

REMARKS

Claims 1-16 and 18-20 are rejected under 35 U.S.C. §103 as being unpatentable over *Kroening et al.* (U.S. 6,080,207).

Applicant traverses this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP § 2142:

...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness...

Claims 1, 6, 11, 21 and 22 include:

Claim 1. A method of automatically manufacturing a computer comprising:
a manufacturer receiving an order from a customer;
the customer selecting hardware components and a software package for the computer;
the customer receiving guidance from the manufacturer to assist in selecting the hardware and software;
assembling together the selection of hardware components specified by the order; and
loading onto the computer the software package specified by the order, including:
providing an Internet-accessible page for the customer to specify any desired software modifications;
recording the modifications as an auto-configuration file; and

for each modification in the auto-configuration file, determining configuration data corresponding to the respective modification and entering the configuration data into the computer as the software package is being loaded.

Claim 6. Apparatus for automatically manufacturing a computer, comprising:

- an order unit of a manufacturer for receiving an order from a customer;
- the customer selecting hardware components and a software package for the computer;
- the customer receiving guidance from the manufacturer to assist in selecting the hardware and software;
- an assembly unit for assembling together the selection of hardware components specified by the order; and
- for loading onto the computer, the software package specified by the order including:
 - an Internet-accessible page onto which the customer can specify any desired software modifications;
 - a modification unit for recording the modifications as an auto-configuration file; and
 - for each modification in the auto-configuration file, a control unit for determining configuration data corresponding to the respective modification and entering the configuration data into the computer as the software package is being loaded.

Claim 11. An automated computer manufacturing method comprising:

- a manufacturer receiving an order from a customer;
- the customer selecting hardware components and a software package for the computer;

the customer receiving guidance from the manufacturer to assist in selecting the hardware and software;

downloading the order to a manufacturing unit;

including an auto-configuration indicator in the order for a special configuration requirement;

generating a flag to look for the special configuration requirement;

making an inquiry to a manufacturing database for the special configuration requirement; and if located, applying the special configuration requirement to the order ,and

assembling together the selection of hardware components specified by the order;

loading into the computer the software package specified by the order, including the steps of:

providing an Internet-accessible page for the customer to specify any desired software modifications;

recording the modifications as an auto-configuration file; and

for each modification in the auto-configuration file, determining any configuration data requirement corresponding to the respective modification and entering configuration requirement data into the computer as the software package is being loaded.

Claim 21. A method of automatically manufacturing a computer comprising:

receiving a special configuration computer order from a customer;

providing guidance to the customer for choosing the configuration;

passing the order to a modification unit and then to a validation unit;

checking for consistency between order details and configuration details;

making the configuration details available to a control unit;

- detecting any modification flag in the order details and obtaining corresponding configuration details;
- checking the corresponding configuration details with a database to determine implementation; and
- entering appropriate data into the computer being manufactured.

Claim 22. A method of automatically manufacturing an information handling system comprising:

- a manufacturer receiving a special configuration computer order from a customer;
- the manufacturer providing guidance to the customer for choosing the configuration;
- the manufacturer passing the order to a modification unit and then to a validation unit;
- the validation unit checking for consistency between order details and configuration details;
- after the configuration details are validated, making the configuration details available to a control unit;
- the control unit detecting any modification flag in the order details and obtaining corresponding configuration details;
- the control unit checking the corresponding configuration details with a database to determine implementation; and
- the control unit entering appropriate data into the computer being manufactured.

In the present case, the reference does not teach or provide a teaching or a suggestion for the unique claimed combination. Applicants claim a manufacturing method and system wherein compatible hardware and software are selected with

manufacturer guidance. *Kroening et al.* teaches a computerized network for creating a customized software configuration. This is clearly not claimed by the present invention. Thus, the rejection is improper because, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. In this context, 35 U.S.C. §103 provides that:

A patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains...(Emphasis added)

Because all the limitations of claims 1, 6, 11, 21 and 22 have not been met by the *Kroening et al.* patent, it is impossible to render the subject matter as a whole obvious. Thus the explicit terms of the statute have not been met and the Examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

The Federal Circuit has held that a reference did not render claimed combination *prima facie* obvious in *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), because inter alia, the Examiner ignored a material, claimed, temperature limitation which was absent from the reference. In variant form, the Federal Circuit held in *In re Evanega*, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987), that there was want of *prima facie* obviousness in that:

The mere absence [from the reference] of an explicit requirement [of the claim] cannot reasonably be construed as an affirmative statement that [the requirement is in the reference].

In *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir. 1984), the Federal Circuit reversed a district court holding of invalidity of patents and held that:

The "difference" may have seemed slight (as has often been the case with some of history's great inventions, e.g., the telephone) but it may also have been the key to success and advancement in the art resulting from the invention. Further, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art.

The Federal Circuit has also continually cautioned against myopic focus on the obviousness of the difference between the claimed invention and the prior art rather than on the obviousness vel non of the claimed invention as a whole relative to the prior art as §103 requires. See, e.g., *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986).

Therefore, independent claims 1, 6, 11, 21 and 22 and the claims dependent therefrom are submitted to be allowable.

In view of the above, it is respectfully submitted that claims 1-16 and 18-22 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,



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